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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,042	06/26/2001	Dale F. McIntyre	82994F-P	1724

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,042	MCINTYRE, DALE F.	
	Examiner	Art Unit	
	Kenneth R Coulter	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/11/02</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 – 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 16 of copending Application No. 09/892,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because both Applications teach the following:

1. A method for managing digital image media files comprising the steps of: providing a server for managing access to a digital image media collection stored on a remote user computer of a user, said digital image media collection having at least one digital media file, said at least one digital media file having at least one image file of a predetermined resolution, said server capable of communicating over a communication network with said user computer, said user providing an initial authorization for managing of said

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digital images, and controlling automatic access to said at least one digital media file in said user computer without any further authorization by said user.

2. A method according to claim 1 further comprising the steps of: creating a copy of said at least one digital image file, said copy having a resolution lower than said predetermined resolution.

3. A method according to claim 2 wherein said digital image media file includes additional data with respect to said at least one digital image file.

4. A method according to claim 3 wherein said additional data comprises audio data.

5. A method according to claim 3 wherein said additional data comprises data structure information relating to said at least one digital image media file.

6. A method according to claim 2 further comprising the step of: forwarding said copy to a third party.

7. A method according to claim 2 further comprising the step of: forwarding said copy to a fulfillment provider for providing of goods and/or services with respect to said copy.

8. A method according to claim 7 wherein said fulfillment provider automatically accesses said at least one digital image of a predetermined resolution from said user computer over said communication network.

9. A method according to claim 1 wherein instructions regarding providing of goods and/or services are provided automatically.

10. A method according to claim 9 wherein said instructions are obtained by analyzing said digital image files with respect to a predefined icon representative of instructions.

11. A method according to claim 10 wherein said icon is at least a portion of an image of

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an individual.

12. A system for managing digital image media files, comprising: a server for managing access to a digital image media collection stored on a remote user computer, said digital image media collection having at least one digital media file, having at least one image file of a predetermined resolution, said sever capable of communicating over a communication network with said user computer, and a computer software program for controlling access to at least one digital media file, said software program automatically allowing access by a remote party to said at least one media file without any further authorization by said user.

13. A system according to claim 12 wherein said remote party comprises a fulfillment provider for providing goods and/or services with respect to said at least one digital media file.

14. A system according to claim 13 wherein said software program allows said fulfillment provider to automatically access said at least one digital media file stored in said user digital media collection without any further authorization by said user.

15. A system according to claim 12 wherein said software program is running on said server.

16. A system according to claim 12 wherein said software program is running on said user computer.

17. A computer software product which when loaded into a computer will cause said computer to perform the following step of: allowing controlled access by a service

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provider over a communication network to a user media file stored on a user computer, said user media file having at least one digital image file.

3. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Needham et al. (U.S. Pub. No. 2002/0188735) (Partially Replicated, Locally Searched Peer to Peer File Sharing System).

- 5.1 Regarding claim 1, Needham discloses a method for managing digital image media files comprising the steps of:

providing a server for managing access to a digital image media collection stored on a remote user computer of a user, said digital image media collection having at least

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one digital media file, said at least one digital media file having at least one image file of a predetermined resolution, said server capable of communicating over a communication network with said user computer, said user providing an initial authorization for managing of said digital images, and controlling automatic access to said at least one digital media file in said user computer without any further authorization by said user (Abstract; p. 2, paragraph 14 "each PC stores the owner's collection of personally created digital **photographs** ..."; p. 1, paragraph 11 "The **index information may be selectively propagated** through a public network such as the Internet only between nodes operated by people having social connections ... This in effect creates a **private** peer to peer network within a larger public network ...").

5.2 Per claim 2, Needham does not explicitly teach a method according to claim 1 further comprising the steps of: creating a copy of said at least one digital image file, said copy having a resolution lower than said predetermined resolution.

However, the dissemination of lower resolution files is inherent in the art in order to increase download speed to users with slow Internet access.

5.3 Regarding claim 3, Needham discloses a method according to claim 2 wherein said digital image media file includes additional data with respect to said at least one digital image file (p. 2, paragraph 14 "The files may store any digitally represented data, for example, **audio data**, video data, **image data**, or **text data**.").

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5.4 Per claim 4, Needham teaches a method according to claim 3 wherein said additional data comprises audio data (p. 2, paragraph 14 "audio data").

5.5 Regarding claim 5, Needham discloses a method according to claim 3 wherein said additional data comprises data structure information relating to said at least one digital image media file (p. 2, paragraph 14 "text data").

5.6 Per claim 6, Needham teaches a method according to claim 2 further comprising the step of: forwarding said copy to a third party (Abstract; p. 2, paragraph 14; p. 1, paragraph 11).

5.7 Regarding claim 7, Needham discloses a method according to claim 2 further comprising the step of: forwarding said copy to a fulfillment provider for providing of goods and/or services with respect to said copy (Abstract; p. 2, paragraph 14; p. 1, paragraph 11).

5.8 Per claim 8, Needham teaches a method according to claim 7 wherein said fulfillment provider automatically accesses said at least one digital image of a predetermined resolution from said user computer over said communication network (Abstract; p. 2, paragraph 14; p. 1, paragraph 11).

5.9 Regarding claim 9, Needham discloses a method according to claim 1 wherein

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instructions regarding providing of goods and/or services are provided automatically (Abstract; p. 2, paragraph 14; p. 1, paragraph 11).

5.10 Per claim 10, Needham teaches a method according to claim 9 wherein said instructions are obtained by analyzing said digital image files with respect to a predefined icon representative of instructions (Figs. 1, 2).

5.11 Regarding claim 11, Needham does not explicitly disclose a method according to claim 10 wherein said icon is at least a portion of an image of an individual.

However, the identification of useful icon with an individual's photograph is an inherent feature in web page design in order to improve access to the information.

5.12 Per claims 12 – 17, the rejection of claims 1 – 11 under 35 USC 102(e) (paragraphs 5.1 – 5.11 above) applies fully.

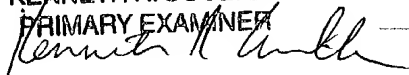
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER



krc